

## REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

Claims 1-10, 13-40 and 42-50 remain pending in this application.

Claims 1-10, 14-24, 39-40 and 42-47 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Application Publication No. 2002/0089968 to Johansson *et al.* (hereinafter “Johansson”) in view of U.S. Application Publication No. 2003/0108172 to Petty *et al.* (hereinafter “Petty”). Applicant respectfully traverses the rejection of the claims for at least the following reasons.

As noted in earlier papers by Applicant, embodiments of the present application relate to obtaining, tracking and maintaining a packet switched network address of client devices that are capable of packet switched communication with the network. In accordance with embodiments of the present invention, a client device is configured to send a packet switched network address when a packet switched data network assigns the client device a new packet switched network address. Accordingly, notification and configuration protocols are provided wherein the client device may move from one zone to another, is in need of a DHCP renewal or is shutting down, requiring re-registration of a new packet data network address to be assigned. See Specification, Paragraphs [043]-[044]. Accordingly, independent claim 1 recites “a client device configured to send a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched network address.”

As previously noted by Applicant, the Office Action cites a combination of references which includes non-analogous art and fails to provide any express indication of a motivation to combine the references. Specifically, Johansson discloses an initial setup situation for the determination of radio transferring capabilities of a receiving station in order to tailor data specific to the receiving capabilities of the receiving station exclusively before a connection with the network is established (i.e., initial setup). Johansson does not relate to activities occurring

after a connection is established. Accordingly, Applicant again submits that this cited reference constitutes non-analogous art.

Further, even if the references are analogous and could be combined, the references, either alone or in combination, fail to teach or suggest each limitation of the claimed invention. Additionally, the Office Action fails to explicitly identify any indication of motivation to combine the cited references.

The Examiner acknowledges that Johansson fails to teach or suggest that the client device sends a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched address. Petty fails to cure this deficiency of Johansson.

The Office Action cites Petty as disclosing this feature at paragraph [0038]. Applicant respectfully disagrees with this interpretation of the disclosure of Petty. Specifically, Petty describes an internet call waiting (ICW) service that allows callers to screen voice messages in real-time to either terminate or re-route the call. Petty's voice message screening and/or the forwarding, re-routing or completion thereof is in no way related to the present application which is to obtain, track and maintained a packet switched network address of client devices capable of packet switched communication with a network. The portion of Petty cited by the Examiner is unrelated to the present application. The cited portion relates to the client software application (ICW) on a personal computer registering on a set time interval with a registration server to in order have update the subscriber's profile, e.g. preferences, online status and IP address for accepting or not accepting voice mail messages. There is no teaching or suggestion in the cited portion of Petty (or anywhere else in Petty) of sending a new packet switched registration message "whenever the packet switched data network assigns the client device a new packet switched network address."

Further, the cited references provide no teaching or combination thereof that would enable a person skilled in the art to produce the device disclosed and claimed within the present

application. Even if the references could be combined, there is absolutely no teaching or suggestion to do so provided by the cited references. When specific claim limitations are missing, the examiner is required to explain why or how the prior art or the general knowledge of the art provides a teaching, suggestion or motivation to modify the prior art to produce the claimed structure. *In re Gal*, 25 USPT2d 1076, 1079 (Fed.Cir. 1992). Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 15 USPQ2d 1566, 1568 (Fed.Cir. 1990).

As noted recently by the U.S. Supreme Court, when looking at the teachings of multiple references, it is to be determined:

... whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

*KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007).

In the present case, the Examiner identifies no clear suggestion or motivation (in either Johansson or Petty) to combine the two references to achieve the claimed invention. Rather, the Examiner merely makes the unsupported assertion that it “would have been obvious to one having ordinary skill in the art” to combine teachings of Johansson and Petty. Applicant respectfully submits that the Examiner’s assertion is without merit.

It is clearly only with improper hindsight, and only with benefit of Applicant’s disclosure, that there is any motivation to undertake the required modification of each of the prior art references to arrive at the present invention. Absent Applicant’s disclosure, there is no motivation to combine the asserted references in order to arrive at the present invention.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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